

REMARKS

Applicant appreciates the Examiner's indication that claims 18-31 are allowable. Additionally, in the Office Action, the Examiner rejected claims 1-17 under 35 U.S.C. § 101 because "claims 1-17 lack practical application since applicant recited 'a random number' is not useful for any practical purpose." (Office Action, paragraph 1).

Regarding the rejection under 35 U.S.C. § 101, for the following reasons, Applicant respectfully traverses this rejection.

M.P.E.P. § 2107 provides guidelines for the examination of applications for compliance with the utility requirement of 35 U.S.C. § 101. This section of the M.P.E.P. lists a number of procedures that office personnel are to adhere to when reviewing patent applications for compliance with the "useful invention" ("utility") requirement of 35 U.S.C. § 101. This section of the M.P.E.P. directs the Examiner to, among other things:

(A) read the claims and the supporting written description,

...

(2) if at any time during the examination, it becomes readily apparent that the claimed invention has a well-established utility, do not impose a rejection based on lack of utility. An invention has a well-established utility if (i) a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention (e.g., properties or applications of a product or process), and (ii) the utility is specific, substantial, and credible.

(M.P.E.P. § 2107) (emphasis added).

Applicant submits that the claimed invention clearly has utility.

Independent claim 1, for instance, is directed to a counter for probabilistically counting a plurality of items. The counter includes a number of elements that define the counter. Independent claim 11 is directed to a method of probabilistically counting a series of items. The method includes a number of acts defining the method. The Examiner can appreciate that counters, and methods for counting items, are clearly practical, useful, applications, as there are many applications in which it is desirable to obtain a count of items. The "Background of the Invention" section of the current application, for instance, discusses at least one environment, (i.e., network routers), in which counters are useful. Accordingly, Applicant submits that the inventions recited in claims 1-17 have clear utility.

It appears to Applicant that the Examiner may be improperly interpreting the utility requirement of 35 U.S.C. § 101 to require that every claimed element be independently useful instead of the claimed invention. Applicant reminds the Examiner that the invention is defined by the claims, and not by a single element in the claims. However, even assuming, *arguendo*, that the Examiner is correct in the assertion that a single "non-useful" element in a claim can potentially make the claim non-compliant with 35 U.S.C. § 101, Applicant submits that claims 1-17 still define statutory subject matter because random numbers and random number generators, as recited in claims 1-17, have practical application.

Independent claim 1 includes "a random number generator configured to generate a random number in a range defined by a first value." Despite the

Examiner's allegations, random number generators and the random numbers they generate are useful in many applications. Just because a number is randomly generated does not mean it is not practically useful. Page 6 and 7 of Applicant's specification, for instance, describe a use for randomly generated numbers. Additionally, Applicant submits that random numbers and random number generators are known and used extensively in a number of different technological fields, such as cryptography and computer science.

For at least these reasons, the rejection of independent claim 1 and its dependent claims 2-10 under 35 U.S.C. § 101 should be withdrawn.

Independent claim 11 is a method that includes "generating a random number in a range defined by a first value." Based on reasons similar to those discussed above, Applicant submits that the random number generated in this claim does not make the claim lack utility under 35 U.S.C. § 101. Accordingly, the rejection of this claim and its dependent claims 12-17 should be withdrawn.

In view of the foregoing remarks, Applicant submits that the claimed invention is statutory under 35 U.S.C. § 101. Applicant, therefore, requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

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